

whether the “interposed isolation regions” means an isolation region that contacts the first and second regions or an isolation region that merely lies somewhere between the two regions. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). When the instant claims are given their broadest reasonable interpretation consistent with the specification, it is clear, that the instant claims fully comport with the requirements of the 35 U.S.C. § 112. The Examiner appears to be objecting to the breadth of the claims, however, the breadth of a claim is not to be equated with indefiniteness. *See In re Miller*, 441 F.2d 689, 169 USPQ 597 (C.C.P.A. 1971). “If the scope of the subject matter embraced by the claims is clear, and if applicant has not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph.” MPEP 2173.04.

“[C]laim terms are given their ordinary and accustomed meaning unless examination of the specification, prosecution history and other claims indicates that the inventor intended otherwise.” *Nike Inc. v. Wolverine World Wide, Inc.*, 43 F.3d 644, 646 (Fed. Cir. 1994). As the Federal Circuit recently set forth, “[t]he second paragraph [of 35 U.S.C. § 112] requires us to look to the language of the claims to determine what ‘the applicant regards as his invention.’” *Phillips v. AWH Corporation*, 415 F.3d 1303, 1312 (Fed. Cir. 2005). The Federal Circuit further explained in *Phillips*, “[i]mportantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the particular claim in which the disputed term appears, but in the context of the **entire** patent,

including the specification," *Phillips* at 1313, and "[a] fundamental rule of claim construction is that terms in a patent document are construed with the meaning which they are presented in the patent document. Thus claims must be construed so as to be consistent with the specification, of which they are a part" *Phillips* at 1316 (citing *Merck co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003)).

The Examiner cited the dictionary definition of "interposed" to reason that interposed was indefinite as used in the instant claims. In *Phillips*, the Federal Circuit issued a warning about relying too heavily on extrinsic sources, such as dictionaries, instead of relying on the specification and the prosecution history. "The main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent." *Phillips v. AWH Corporation*, 415 F.3d 1303, 1321 (Fed. Cir. 2005). The Federal Circuit further recognized the distinction between the using the specification to interpret the meaning of a claim and importing limitations from the specification and "expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment." *Phillips* at 1323 (citing *Gemstar-TV Guide Int'l, Inc. v. Int'l Trade Comm'n*, 383 F.3d 1352, 1364 (Fed. Cir. 2004)).

The Examiner apparently wants to narrow the definition of "interposed" to mean located between **and** formed immediately adjacent to and in contact with. The Examiner rooted through the specification to find some justification for this unwarranted additional limitation. The Examiner relied on a portion of the specification describing the formation of a gate oxide layer to declare that "interposed" as used in the specification means "not only 'located between,' but 'formed immediately adjacent to and in contact with.'"

First, the Examiner ignored the entirety of the teaching in the claims, specification, and drawings which make clear to one of ordinary skill in this art what is meant by "interposed isolation regions," as recited in the instant claims. As the Federal Circuit has explained, claim terms are interpreted in context of the entire patent.

Second, the Examiner relied on a sentence in the summary describing the formation of a gate oxide layer of a FET to conclude that first and second regions of the semiconductor substrate spaced apart from each other by interposed isolation regions is indefinite. The Examiner is comparing two different portions of the semiconductor device (gate oxide layers and isolation regions) to support the rejection. Further, the independent claims are not limited to FETs. The Examiner clearly overreaches in using this comparison to provide the basis for the rejection.

Third, the Examiner improperly narrow the definition of "interposed." As described in the Summary of the Invention, "The first FET comprises a gate electrode formed over the SiGe layer, and a **gate oxide layer interposed** between the gate electrode and the SiGe layer, wherein the **gate oxide layer** is formed **immediately adjacent to and in contact** with the SiGe layer." As clearly set forth in this sentence, this portion of the specification describes an embodiment where the gate oxide layer is both between the gate electrode, and immediately adjacent and in contact with the SiGe layer.

Fourth, the Examiner is improperly importing limitations from the specification into the claims. The Examiner has apparently decided, based on the Examiner's interpretation of the formation of a gate oxide layer described in the specification, that "interposed" means "formed immediately adjacent to and in contact with," and is imports this limitation into the instant claims to describe the location of the isolation regions. However, limitations from the specification are not to be imported into the claims.

As is clear from the instant claims and the specification, the isolation regions are formed between the first regions and the second regions. The rejections under 35 U.S.C. § 112, second paragraph, are untenable and should be withdrawn. Therefore, it is respectfully submitted that claims 10-27 should be to entitled the broadest reasonable interpretation and broadest range of equivalents that are appropriate in light of the language of the claims, the supporting disclosure and Applicant's prosecution of the claims, in accordance with well-settled patent law.

Therefore, in light of the above Remarks, this application should be allowed and the case passed to issue. If there are any questions regarding these remarks or the application in general, a telephone call to the undersigned would be appreciated to expedite prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Bernard P. Codd

Registration No. 46,429

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BPC:MWE
Facsimile: 202.756.8087
Date: January 17, 2006

**Please recognize our Customer No.
20277 as our correspondence address.**